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08/900,360 07/25/97 OBRECHT

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EXAMINER

MEINECKE DIAZ, S

ART UNIT

PAPER NUMBER

2765

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/900,360

Applicant(s)

Obrecht

Examiner  
Susanna Meinecke-Díaz

Group Art Unit  
2765



☒ Responsive to communication(s) filed on Jun 21, 2000

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Response to Amendment*

1. This office action is responsive to Applicant's response and declaration filed on June 21, 2000.

Claims 1-20 are pending.

2. The declaration filed on June 21, 2000 under 37 CFR 1.131 has been considered but is ineffective to overcome the reference entitled "IBNL Forges Into the Future of Buying and Selling with Source Interactive Software" (ref. X).

The declaration is vague and says, "Less than three weeks from the date of January 10, 1996, I worked on drafts of the Exhibit A, title 'High Level Design Automotive Live Market Exchange System.'" Technically, it does not say whether the inventor worked on the drafts three weeks before or after January 10, 1999 and, in a previous declaration under 37 CFR 1.131, the inventor only states that Exhibit A was "published before February 22, 1996." Furthermore, the 103 rejection of record rejects claims 1-20 over the product Source Interactive Software in view of Salmon et al. The previous Examiner cited several articles to describe said product. The present Examiner asserts that the product disclosed in detail in the X reference ("IBNL Forges Into the Future of Buying and Selling with Source Interactive Software") is the same product which is addressed as early as in the U reference entitled "Interactive Buyers Net: Buyer/Seller

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Interactive Software Inc. Acquired, New Software Introduced” which was published August 22, 1995. The name *Source Interactive Software* is explicitly disclosed as early as November 15, 1995 in the V reference entitled “IBNL Announces Signing of More than \$8 Billion in Buyer Power.” As matter of fact, the article “IBNL Declares 20 Percent Stock Dividend; SOURCE Interactive Software Systems Operational” (reference W, published December 14, 1995) mentions that Internet access will be available by the first quarter of 1996, which suffices as a disclosure of the Internet embodiment of *Source Interactive Software* dating back at least to December 14, 1995. These facts are further supported by the following excerpt from reference X (“IBNL Forges Into the Future of Buying and Selling with Source Interactive Software”):

“The advent of SOURCE creates a low-cost interactive marketplace where the seller can go to a ready buyer and exactly know his needs. “Several major players in a diverse range of business sectors already are interactively participating in this marketplace of the future, including Burbank Glendale Pasadena Airport, Los Angeles County ISD,..., among others. Collectively, their accounts boast a pool of buyers in excess of 30,000 vendors.” (Sections 1 and 2)

The X reference also indicates that *Source Interactive Software* was made public long before January 10, 1996; otherwise, there would not likely be such a large pool of participants by the time said reference was published. Consequently, the inventor needs to swear behind the *Source Interactive Software* as a whole, taking into account its earlier date of disclosure, in order to provide an effective declaration under 37 CFR 1.131.

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***Response to Arguments***

3. Applicant's arguments filed June 21, 2000 have been fully considered but they are not persuasive.

(A) The Applicant objects to the fact that references U, V, W, X, U(2), V(2), and Salmon were cited in the preamble of the 103 rejection; however, only the references U, V, X, and Salmon were actually used in the body of the rejection (page 2 of Applicant's response). The Examiner asserts that references U, V, W, X, U(2), and V(2) were used to show the history of the product *Source Interactive Software*. Claims 1-20 were rejected over the product *Source Interactive Software* in view of Salmon. Examiner Crecca explained, in paper no. 11, why claims 1-20 were deemed obvious in light of the product *Source Interactive Software* in view of Salmon. She met her burden of establishing a prima facie case by adequately addressing the rejection of claims 1-20 over the product *Source Interactive Software* in view of Salmon and was under no obligation to cite each and every supporting reference in the body of the rejection since all references *collectively* contribute to the description of the product *Source Interactive Software*.

(B) The Applicant comments the following:

"The quotation from reference 'X', paragraph 8 does not at all meet the steps, in for example claim 1(c) and (d). In the 'X' reference, the sellers first identify their products and when a buyer sends out a request that matches the category, sellers are connected to the request of the buyers. This is completely different than is set forth for example in base claim 1." (Pages 2-3 of Applicant's response)

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The Applicant is arguing elements not explicitly found in the claim language. Claim 1 does not even address whether the sellers identify their products first or whether the buyers send out a request message first. Further, the Applicant is reminded that although the steps of a method claim may be labeled as (a), (b), (c), etc., there is no express limitation that says that step (a) occurs before step (b) which occurs before step (c), etc., unless explicitly stated so in the claim.

(C) The Applicant argues that Salmon teaches the ranking of the products themselves and not of the sellers per se (page 3 of Applicant's response). Examiner Crecca explained why she felt it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to combine the teachings of the product *Source Interactive Software* with the Salmon patent to anticipate steps (e) through (g) of claim 1. Step (f) recites "ranking the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking." By associating a product with a particular seller and then ranking each product, inherently the seller is being ranked in respect to his/her product. As a matter of fact, the Applicant's own specification explains that the ranking of the sellers is commonly based on the extent to which their respective products match what the buyer is looking for. "Also, the quotes provided by the dealers are ranked on the report, wherein the quote of dealer 13 is the best match and is therefore labeled 'A,' dealer 14 is labeled 'B,' and dealer 15 is labeled 'C'" (Page 21 of the specification). Presumably product information must come from each respective seller in the Salmon patent; therefore, by ranking products, the sellers are inherently ranked as well.

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Such a scenario meets one of the examples given in the specification and also meets the corresponding, broadly claimed limitations of claim 1 (i.e., step (f) in particular). Furthermore, the Applicant has not explicitly given any specific definition to the term "ranking" which might preclude the validity of the Examiner's interpretation of the Salmon reference as anticipating steps (e) through (g) of claim 1.

(D) The Applicant argues the interpretation of the word "selecting" in the claims as it applies to the cited references (page 3 of Applicant's response). The Applicant is correct that he can be his own lexicographer; however, he fails to explicitly define his preferred interpretation of the word "selecting." This word is extremely broad in nature and the Examiner has no justification for reading the entire specification into one word. If the Application wants the word "selecting" to be interpreted in a way contrary to popular usage of the word, he must point out where in the specification "selecting" was explicitly defined or he must clearly incorporate the intended limitations of the word "selecting" in the claims themselves.

(E) The Applicant argues that, "With respect to the motivation (point 2), it is not understood from the Office Action what Salmon would suggest to one skilled in the art in modifying the primary references, V, X or U" (page 4 of Applicant's response). In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner Crecca's motivation to combine references came from the knowledge generally available to one of ordinary skill in the art.

(F) The Applicant comments that, "In this rejection, the Patent Office took Official Notice regarding 'previously owned automobiles.' Claim 20 is a dependent claim and does not rely on this limitation alone for patentability" (page 4 of Applicant's response). The Examiner understands this; this is why claim 20 was rejected as being unpatentable over "*Interactive Source* [the product *Source Interactive Software*] in view of Salmon et al. **as applied to claim 19 above**" (*Emphasis added*, page 8 of paper no. 11). The rejection of claim 20 inherently incorporates the rejection applied to claim 19 in addition to the Official Notice statement made regarding claim 20 in particular.

(G) The Applicant argues that since the Fujisaki patent was not used in the heading of the rejection, the use of this reference is improper (page 5 of Applicant's response). The Fujisaki patent was not officially part of the rejection. Instead, it was used to provide support for the Official Notice statement made by Examiner Crecca.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the product *Source Interactive Software* (hereinafter referred to as *Source Interactive* or *Interactive Source*, described in references U, V, W, X, U(2), and V(2)) in view of Salmon et al. (U.S. Patent No. 5,592,375), as discussed in sections 3-5 of paper no. 11.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Development of a Performance Based Design/Procurement System for Nonstructural Facility Systems: Discloses a system for providing clients with a ranked list of contractors, based on the particular requirements of the clients. This dissertation serves as a precursor to the Applicant's invention.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Meinecke-Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SMD  
September 8, 2000



ERIC W. STAMBER  
PRIMARY EXAMINER